

REMARKS

Summary Of The Office Action & Formalities

Claims 1-12 are all the claims pending in the application. By this Amendment, Applicant is amending claims 1-10, and adding new claims 13 and 14. No new matter is added.

Applicant thanks the Examiner for acknowledging that the replacement drawing sheet, the amendments to the specification and abstract of the disclosure, the amendments to claims 1-10, and the addition of new claims 11 and 12 in the submission dated August 1, 2005 are accepted.

The prior art rejections are summarized as follows:

1. Claims 1-3, 5-8, and 10-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kadrmas (US 3,781,552), of record.

2. Claims 4 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kadrmas in view of Weiss (US 3,371,212), of record.

Applicant respectfully traverses.

Claim Rejections - 35 U.S.C. § 102

1. Claims 1-3, 5-8, and 10-12 In View Of Kadrmas (US 3,781,552).

In rejecting claims 1-3, 5-8, and 10-12 in view of Kadrmas (US 3,781,552), the Examiner maintains the previous grounds of rejection and further states:

The Applicants' arguments filed 8/1/05 have been fully considered but they are not persuasive.

The Applicants argue that, with respect to newly amended Claims 1 and 6, Kadrmas fails to teach or reasonably suggest the transmitting beam axis incident to the primary optical surface not

coinciding with the receiving beam axis incident to the primary optical surface. The Examiner respectfully disagrees. In particular, it is noted that the features upon which applicant relies (i.e., *optical* axes of both the receiver and source) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, Claim[s] 1 and 6 only recite “the at least one transmitting beam having a corresponding axis” and “the receiving beam having an axis”. Kadrmas discloses (See Figure 1 of Kadrmas, reproduced and annotated below) the transmitting beam having an axis of propagation (one of an infinite number of axes of propagation since the transmitting beam is donut shaped). Similarly, the receiving beam has an axis of propagation (again one of an infinite number of axes of propagation since the receiving beam is also donut shaped, of which only a discrete number are detected by photosensors). Both of the particular axes shown do not coincide.

Office Action at pages 2-3. Applicant respectfully disagrees.

In order to anticipate a claim under 35 U.S.C. § 102, the reference must teach every element and limitation of the claim. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus the reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

The Examiner is reading claims 1 and 6 in the present invention in a manner broader than that supported by the specification. In the recently decided case *Phillips v. AWH*, the Federal Circuit held that claim language is to be read in light of the specification. *Phillips v. AWH*, 415 F.3d, 1303, 1312 (Fed. Cir. 2005) (*en banc*). The Examiner has rejected claims 1 and 6 in the most recent Office Action on the basis of an interpretation of the location of the axes in Kadrmas that is inconsistent with the interpretation that should be given the claims in the present invention in view of the specification. The Examiner argues that the beams in Kadrmas have an infinite

number of axes of propagation since the transmitting beam is donut shaped. This interpretation of the location of the axis of the transmitting beam is unfounded in light of the specification.

When Kadrmas is properly read in light of the current specification, the axes for the transmitting beam and the receiving beam are in the centers of the respective beams. In Kadrmas, these axes coincide which is different from what is clearly required by claims 1 and 6. Therefore, Kadrmas cannot fairly be said to suggest or teach all of the limitations of claims 1 and 6.

In view of the foregoing, claims 1 and 6 and dependent claims 2, 3, 5, 7, and 10-12 are patentable over the applied art.

Claim Rejections - 35 U.S.C. § 103

2. Claims 4 And 9 Over Kadrmas in view of Weiss (US 3,371,212).

In rejecting claims 4 and 9 over Kadrmas in view of Weiss (US 3,371,212), the grounds of rejection state:

Kadrmas discloses the invention as set forth above in Claims 1-2, 6-7, except for the at least one transmitting device being placed fundamentally in front of the reflecting optical surface. However, it is well known in the art for such transmitting telescopic optical systems to place the transmitter or source either behind or in front of the reflecting face of the main reflector of the telescopic optical system. For example, Weiss teaches a conventional transmitting and receiving telescopic optical system (See Figure), wherein the transmitting optical source (See 50 in Figure) is placed in front of (i.e. in locations where the reflecting surface of the primary mirror face) the reflecting surface of the main reflector (See 12 in Figure) of the telescope. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the at least one transmitting device be placed fundamentally in front of the reflecting optical surface, as taught by Weiss, in the telescope and method of Kadrmas, for reducing the physical size of the telescope

optical system, while making the source readily accessible for replacement if the source is damaged or requires replacement.

Office Action at page 6.

Claims 4 and 9 are also patentable over the prior art. The Examiner argues that Kadrmas in view of Weiss discloses all of the elements of claims 4 and 9, as well as the base claims, claims 1 and 6. As noted above, Kadrmas fails to disclose all of the elements of claim 1. Therefore, since Weiss does not cure the above-noted deficiencies found in Kadrmas, claims 4 and 9 are patentable at least by virtue of their dependencies.

New Claims

For additional claim coverage merited by the scope of the invention, Applicant is adding new claims 13 and 14 which merely make explicit inherent features of claims 1 and 6. These claims are believed to be allowable by reason of their respective dependencies, as well as because -- as acknowledged by the Examiner -- Kadrmas fails to disclose beam axes that do not coincide.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.116
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Respectfully submitted,



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